

AMENDMENT

U.S. Appln. No.09/531,658

5000-1-081

SUMMARY OF THE REJECTIONS:

(1) Claims 1, 3-9, 11-16, 18-24, and 26-43 stand rejected as allegedly being obvious under 35 U.S.C.§103(a) over Alperovich et al. (U.S. 6,175,743 hereafter "Alperovich") in view of Payne et al. (U.S. 6,021,433 hereafter "Payne").

(2) Claims 2, 10, 17 and 24 stand rejected under 35 U.S.C.§103(a) as allegedly unpatentable over Alperovich in view of Payne and Goris et al. (U.S. 6,243,081).

ARGUMENT:

(1) Rejection of Claims 1, 3-9, 11-16, 18-24, and 26-43 stand rejected as allegedly being obvious under 35 U.S.C.§103(a)"

Examiner's Position:

(1) It is alleged in the Office Action that Alperovich discloses a data transmission apparatus for a digital mobile station in which encapsulating header information for a Short Message Service (SMS) message includes the header information in the SMS message. It is further admitted in the Office Action that Alperovich fails to teach an encoding section for reading and encoding data in a predetermined form, a data transmission header generating section, or a data storage section. However, it is alleged that Payne discloses an encoding section for reading and

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encoding data in a predetermined form, and a data transmission header generating section and a storage section. Allegedly, the instant claims would have been obvious over the adaptation of Alperovich to include an encoding section for reading and encoding data in a predetermined form, a data transmission header generating section to generating distinctive headers corresponding to encoded data, and a data storage section to allow a variety of data to be transmitted and received.

Applicants' Traversal:

Applicants respectfully submit that none of the instant claims would have been obvious over the combination of Alperovich and Payne.

First, it is respectfully submitted that there is no motivation to combine the teachings of Alperovich and Payne. Assuming *arguendo*, even if an artisan were to have had both of Alperovich and Payne in front of him, the suggestion or motivation comes from the presently claimed invention, not from any teachings of the combination of references.

Short Message Service (SMS) heretofore enabled the transmission of alphanumeric messages between mobile subscribers and external systems, such as electronic mail, paging, and voice mail system. A distinguishing characteristic of the SMS service is

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that an active mobile handset is able to receive or submit a short message at any time, independent or of whether or not a voice or data call is in progress. In addition, an SMS system allows a user to separately prepare and message and transmit the sentence to another party as a radio signal.

Prior art mobile digital systems had limited capacity to transmit SMS messages, and could not permit the transmission of large amounts of data, for example when required for graphics. The limited size of the SMS block required that a user intended transmitted sentence had to be divided into a series of sub-sentences that were required to be separately prepared and transmitted (specification, page 3, lines 6-22).

In contrast, in the presently claimed invention as recited in claim 1, a data transmitting apparatus includes, *inter alia*, an encoding section for reading and encoding the data stored in a predetermined form, a data transmission header for generating inherent distinction transmission headers that correspond to the encoded data, a control section for forming data and the data transmission headers into user data of an SMS, and a short message transmitting section for transmitting short message service blocks that include the user data.

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For example, by the action of combining the encoded data and the data transmission headers by the control section into SMS blocks according to a format, the user can be transmitted in SMS format.

In contrast, it is respectfully submitted that the combination of Alperovich and Payne fails to disclose, suggest or motivate the artisan to provide an apparatus as recited by instant claim 1. In fact, it is respectfully submitted that a person of ordinary skill in the art would not have found any suggestion, motivation or incentive to combine the teachings of Alperovich, which is drawn to a system to selectively transmit an SMS to certain parties over a broadcast channel, and Payne, which discloses a data transmission system and method for data communication connecting on-line networks with on-line and off-line computers. One purpose of SMS is to permit a mobile handset to transmit and receive alphanumeric messages whether or not a data call or voice call is in progress. The concept of combining the teachings of Alperovich and Payne, would appear to be contradictory. Payne is completely silent regarding the feature of SMS, and merely discloses a system for providing an instant call to action for users who are provided with the ability to instantaneously retrieve further detailed information. The fact that Payne discloses building data blocks and

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assigning addresses to the data block does not, in combination with Alperovich, suggest an apparatus that changes SMS transmission so as to permit large amounts of data, including audio and graphics, for example.

Applicants respectfully submit that the motivation to combine the teachings of the cited references, and the alleged motivation to modify Alperovich in view of Payne, comes only from the instant claims and the teachings of the instant specification, and not from anything gleaned by an artisan with knowledge of the cited references.

Furthermore, Applicants respectfully submit that the Court of Appeals for the Federal Circuit has held in *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to an artisan to modify or combine the references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or combination of references) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found both in the prior art, and not based on the Applicants'*

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disclosure, was an issue in *Vaeck*. In the present case, it is respectfully submitted the criteria of obviousness exemplified by *Vaeck* has not been reached, thus the obviousness rejection is improper.

In addition, Applicants respectfully submit that it was held by the Court of Appeals in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) that:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In the present case, it is respectfully submitted that the teachings of the combination of references do not overcome the standard of establishing obviousness as exemplified in *Fritch*.

Applicants also respectfully submit that claims 2-8 are allowable at least for dependence on claim 1, which is believed to be allowable. In addition, instant claim base claims 9, 15, 21, 26, 30, 35 and 42 are allowable for similar reasons as base claim 1, plus an independent basis for patentability. In addition, it is

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respectfully submitted that all of the claims dependent on these base claims are similarly allowable. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

(2) Claims 2, 10, 17 and 24 stand rejected under 35

U.S.C. §103(a):

Examiner's Position:

With regard to claims 2, 10, 17, and 24 it is alleged that Alperovich and Payne fail to disclose coding data by a run length code. However, it is further alleged that Goris teaches using a run length code, and thus any of claims 2, 10, 17 and 24 would have been obvious to a person of ordinary skill in the art to adapt by using a run length code as disclosed by Goris to encode data to allow for an alternate form of coding to be used for varying data.

Applicants' Traversal:

First, Applicants respectfully submit that there is no disclosure, motivation, or suggestion found in the references that would have made an artisan find it obvious to include a run length code as an alternate form of coding. Why would an alternate form of coding be desirable in the combination of Alperovich and Payne? A *prima facie* case of obviousness has not been stated. Second, for reasons previously indicated, the invention recited in the base claims is not obvious over the combination of Alperovich and Payne,

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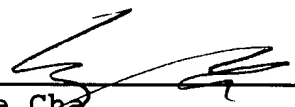
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and it is respectfully submitted that Goris fails in combination with the other cited references to overcome the deficiencies of the combination already discussed above. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Should the Examiner deem that there are any issues which may be best resolved by telephone communication, he is respectfully requested to telephone Applicants' undersigned Attorney at the number listed below.

Respectfully submitted,

  
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SC/lc

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